

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
Remy Cricco et al.)	Group Art Unit: 2617
Application No.: 10/534,880)	Examiner: M. T. Vu
Filed: June 16, 2005)	Confirmation No.: 8760
For: LOADING AN APPLICATION TO)	
BE DEPLOYED IN A TERMINAL)	
AND A CHIP CARD)	

APPEAL BRIEF

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal is from the decision of the Examiner in the Final Office Action mailed September 18, 2008 and Appellant's Notice of Appeal filed February 18, 2009, setting a period for response that extends through May 18, 2009, by a Petition for Extension of Time (one month) filed herewith.

Please charge the \$540.00 fee for filing this Appeal Brief to credit card. The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

I. Real Party in Interest

The present application is assigned to Gemplus, now GEMALTO SA. GEMALTO SA is the real party in interest, and Gemplus is the assignee of Application No. 10/534,880.

II. Related Appeals and Interferences

None.

III. Status of Claims

Claims 1-10 were originally filed in this application. Claims 11-13 were added by an Amendment filed December 18, 2007.

The present status of the claims is as follows:

- claims 1-13 are rejected under 35 U.S.C. § 103(a); and
- claims -13 are being appealed.

IV. Status of Amendments

None.

V. Summary of Claimed Subject Matter Recited in Claims 1 & 11-13

Appellant's specification discloses loading of an application from an application server into a terminal with a chip card. For instance, the terminal can be a mobile radiotelephone connected to the server through a telecommunications network and the chip card can be an identity module (e.g., a Subscriber Identity Module or "SIM") that can be removed from the terminal. In an exemplary embodiment, a server deploys an application to a terminal and to a chip card. To deploy the application, the server formats a message, which contains both a first application part and second application part, to be compatible with a protocol for communication between the terminal and the card. The message is transmitted by the server to the terminal, which stores the two parts. The first part (APT) is extracted

from the application message and is installed in the terminal. A specific loader loads the second part extracted from the message according to the communication protocol. The installations of the two application parts are thus synchronously under the control of the terminal.

The present application contains four (4) independent claims – 1, 11, 12 & 13. A mapping of each of the independent claims to one instance of an exemplary embodiment described in the disclosure is set forth in the following table:

<u>Claim 1 Features</u>	<u>Supporting Disclosure in Published Application</u>
A method for loading an application from a server, said application including a first part intended for a terminal provided with an application management means (GIA) and a second part intended for a chip card accepted in the terminal, the method comprising the following steps:	FIGs. 3, 4; p. 3, ¶ 0043; “application management means,” FIG. 2: GIA; FIG. 4: T2-T4; p. 3, ¶ 0039; p. 4, ¶¶ 0049-50
- supplying to the terminal a loading means for loading the second application part in the chip card;	FIG. 4: E0; p. 1, ¶ 0011; p. 3, ¶ 0044; “loading means,” FIG. 2: CAPC; FIG. 4: T5-T7; p. 2, ¶ 0041; p. 4, ¶¶ 0050-52;
- formatting in the server the second application part so that it is compatible with a protocol for communication between the terminal and the chip card;	FIG. 4: S3; p. 1, ¶ 0012; p. 2, ¶ 0034; p. 3, ¶ 0046
- constructing in the server an application message containing the first application part and the second formatted application part;	FIG. 4: S4; p. 1, ¶ 0013; p. 2, ¶ 0030; p. 3, ¶ 0036; p. 3, ¶ 0046
- transmitting the application message from the server to the terminal over a single transmission channel;	FIG. 4: S5; p. 1, ¶ 0014; p. 3, ¶ 0047
- installing in the terminal the first application part extracted from the application message via the management means; and	FIG. 4: T2-T3; p. 1, ¶ 0015; p. 4, ¶ 0049

- loading the second application part extracted from the application message from the terminal into the chip card according to the predetermined communication protocol under the control of the loading means.	FIG. 4: T4-T5; p. 1, ¶ 0016; p. 3, ¶ 0041; p. 4, ¶¶ 0050-51;
<u>Claim 11 Features</u>	<u>Supporting Disclosure in Published Application</u>
A method for loading a message including application components from a server to a terminal, said message including a first part identified for installation on the terminal and a second part identified for installation on a chip card accepted in the terminal, the method comprising the following steps:	FIGs. 3, 4; p. 3, ¶ 0043; “application management means,” FIG. 2: GIA; FIG. 4: T2-T4; p. 3, ¶ 0039; p. 4, ¶¶ 0049-50
- receiving, over a single transmission channel between the server and terminal, the application message containing the first application part and the second formatted application part;	FIG. 4: S5; p. 1, ¶ 0014; p. 3, ¶ 0047
- installing in the terminal the first application part extracted from the application message via a management means; and	FIG. 4: T2-T3; p. 1, ¶ 0015; p. 4, ¶ 0049
- loading the second application part extracted from the application message from the terminal into the chip card under the control of a loading means received from the server.	FIG. 4: T4-T5; p. 1, ¶ 0016; p. 3, ¶ 0041; p. 4, ¶¶ 0050-51; “loading means,” FIG. 2: CAPC; FIG. 4: T5-T7; p. 2, ¶ 0041; p. 4, ¶¶ 0050-52;
<u>Claim 12 Features</u>	<u>Supporting Disclosure in Published Application</u>
A computer-readable medium storing program instructions that, when executed by a processor, instruct the processor to perform a method for loading a message including application components into a terminal, said message including a first part identified for installation on the terminal and a second part identified for installation on a chip card accepted in the terminal, the method comprising the following steps:	FIGs. 2-4; p. 3, ¶ 0043
- receiving, over a single transmission channel between the terminal and a server, the message containing the first application part and the second formatted application part;	FIG. 4: S5; p. 1, ¶ 0014; p. 3, ¶ 0047

- installing the first application part extracted from the application message in the terminal; and	FIG. 4: T2-T3; p. 1, ¶ 0015; p. 4, ¶ 0049
- loading the second application part extracted from the application message from the terminal into the chip card under the control of a loading means received from the server.	FIG. 4: T4-T5; p. 1, ¶ 0016; p. 3, ¶ 0041; p. 4, ¶¶ 0050-51; “loading means,” FIG. 2: CAPC; FIG. 4: T5-T7; p. 2, ¶ 0041; p. 4, ¶¶ 0050-52;
<u>Claim 13 Features</u>	<u>Supporting Disclosure in Published Application</u>
A system for loading a message including application components, the system comprising:	FIGs. 2-4; p. 3, ¶ 0043;
a server (1);	FIG. 2: 1
a terminal (2) including a loading means (CAPC) received from the server;	FIG. 2: 2, CAPC; “loading means,” FIG. 2: CAPC; FIG. 4: T5-T7; p. 2, ¶ 0041; p. 4, ¶¶ 0050-52;
a chip card (3) detachably connected to the terminal; and	FIG. 2, 3
a transmission channel (RT) between the server (1) and terminal (2),	FIG. 2, RT
wherein the terminal (2) is configured to:	
- receive over the transmission channel (RT) an application message (MAP) including a first application part (APT) identified for installation on the terminal and a second formatted application part (APC) identified for installation on the chip card (3);	FIGs. 2, 4: S5; p. 1, ¶ 0014; p. 3, ¶ 0047
- install the first application part (APT); and	FIGs. 2, 4: T2-T3; p. 1, ¶ 0015; p. 4, ¶ 0049
- load the second application part (APC) extracted from the application message (MAP) from the terminal (2) into the chip card (3) under the control of the loading means (CAPC)	FIGs. 2, 4: T4-T5; p. 1, ¶ 0016; p. 3, ¶ 0041; p. 4, ¶¶ 0050-51;

VI. Grounds of Rejection to be Reviewed on Appeal

(1) Whether claims 1-13 are patentable under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2002/0056079 by *Sato et al.* ("*Sato*") in view of U.S. Patent No. 6,571,112 to *Ramaswamy*.

VII. Argument

(1) Rejection of Claim 1-13 Under 35 U.S.C. § 103

Appellant traverses the rejection of claim 1-13 under 35 U.S.C. § 103(a) as allegedly not being patentable over the purported combination of *Sato* and *Ramaswamy*. To support a rejection under Section 103(a), the Examiner must establish, *inter alia*, that all the elements recited in the Applicant's claims were known in the prior art. (*See KSR International Co. v. Teleflex Inc.*, 550 U.S., No. 04-1350 (U.S., April 30, 2007), 82 USPQ2d 1385, 1395 (2007); M.P.E.P. § 2143.02.) The purported combination of *Sato* and *Ramaswamy* fails in at least this regard.

(A) Claim 1

Sato provides a method for loading an application program onto a reissued smart card from a terminal unit. (*Sato*, Abstract; ¶¶ 0007-08.) The Examiner concedes that *Sato* does not disclose or suggest "loading [a] second application part extracted from the application message from the terminal into the chip card according to the predetermined communication protocol under the control of the loading means," as recited in claim 1. (Final Office Action, p. 3, first full paragraph.) *Sato* fails to teach other features of claim 1 as well.

The Examiner apparently believes the *Sato's* application data stored in smart card application management database 110 corresponds to the "first part." (Final Office Action, p. 2.) However, the application data is merely "data related to the smart card" -- it is not part of an application. (*Sato*, ¶¶ 0103, 0121; FIGs. 14 & 17.) Moreover, nowhere does *Sato* disclose

that the application data is loaded into terminal 111 or smart card 11. Indeed, *Sato* says nothing with regard to an "application including a first part ... and a second part," as recited in claim 1. As shown in FIG. 1, *Sato's* method loads an entire application onto a reissued smart card 11 from a terminal 111. (*Id.* at ¶¶ 0080, 0086. 0080; FIG. 2; FIG. 8, step 808; & FIG. 11, step 1108.) Accordingly, *Sato* does not disclose or suggest, at least, "a first part intended for a terminal," or "a second part intended for a chip card accepted in the terminal," "installing in the terminal the first application part extracted from the application message via the management means," and "loading the second application part extracted from the application message from the terminal into the chip card."

Ramaswamy does not overcome *Sato's* deficiencies. *Ramaswamy* relates to a method for processing an encapsulating message 104 including an embedded 510 message at a mobile station having a subscriber identity module (*Ramaswamy*, col. 1:44-59.) *Ramaswamy* determines whether or not to transfer the encapsulating message 104 to subscriber identity module 108 from mobile station 106. (*Id.* at col. 2:8-11.) That is, the entire encapsulating message 104 is either extracted in mobile device 106 or transferred to subscriber identity module 104. (*Id.*) *Ramaswamy*, therefore, does not disclose or suggest dividing encapsulating message 104 or embedded message 510 into more than one "part." Accordingly, *Ramaswamy* also fails to disclose or suggest the above-noted "first application part" and "second application part."

In addition, *Ramaswamy* does not disclose or suggest placing one part of encapsulating message 104 or embedded message 510 in mobile station 106 and another part in subscriber identity module 108. As noted above, the entire encapsulating message 104 is either extracted in mobile device 106 or transferred to subscriber identity module 104. (*Id.* at col. 2:8-11.) Accordingly, *Ramaswamy* cannot be considered to disclose or suggest

“installing in the terminal the first application part extracted from the application message” and “loading the second application part extracted from the application message from the terminal into the chip card,” as recited in claim 1.

Furthermore, *Sato* and *Ramaswamy* do not describe "a loading means for loading the second application part in the chip card" or "formatting in the server the second application part so that it is compatible with a protocol for communication between the terminal and the chip card," as recited in claim 1. The Final Office Action cites *Sato*'s paragraphs 0076 to 0084 for allegedly disclosing these features. (Final Office Action, p. 3.) However, neither the paragraphs cited in the Office Action nor any other portion of *Sato* say anything with regard to the claimed "loading means" or "formatting." *Ramaswamy* also appears to be silent with regard to these features and the Examiner does not rely on *Ramaswamy* for such disclosure. Accordingly, the purported combination of *Sato* and *Ramaswamy* fail to disclose or suggest these features as well.

Because *Sato* and *Ramaswamy* fail to disclose or suggest the above-identified features of claim 1, the references, whether taken individually or in combination, do not disclose or suggest the subject matter recited in Appellant's claim 1. The purported combination of *Sato* and *Ramaswamy* cannot, therefore, support a rejection of claim 1 under 35 U.S.C. § 103(a). Claim 1 is, therefore, allowable over *Sato* and *Ramaswamy*.

(B) Claims 2-10

Claims 2-10 are allowable over the applied references at least due to their dependence from claim 1.

(C) Claim 11-13

Claims 11-13, although of different scope than claim 1, recite features similar to those recited in claim 1. Thus, claims 11-13 are allowable over *Sato* and *Ramaswamy* for similar reasons to those set forth above with regard to claim 1.

VIII. Claims Appendix

See attached Claims Appendix for a copy of the claims involved in the appeal.

IX. Evidence Appendix

None.

X. Related Proceedings Appendix

None.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date May 18, 2009

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VIII. CLAIMS APPENDIX

Claims involved in the appeal of U.S. Patent Application Serial No. 10/534,880:

1. (Previously Presented) A method for loading an application from a server, said application including a first part intended for a terminal provided with an application management means and a second part intended for a chip card accepted in the terminal, the method comprising the following steps:
 - supplying to the terminal a loading means for loading the second application part in the chip card;
 - formatting in the server the second application part so that it is compatible with a protocol for communication between the terminal and the chip card;
 - constructing in the server an application message containing the first application part and the second formatted application part;
 - transmitting the application message from the server to the terminal over a single transmission channel;
 - installing in the terminal the first application part extracted from the application message via the management means; and
 - loading the second application part extracted from the application message from the terminal into the chip card according to the predetermined communication protocol under the control of the loading means.
2. (Previously Presented) A method according to Claim 1, wherein the application message includes a descriptor of the application includes at least one identifier of the second

application part, and the management means analyzes the descriptor in the application message received by the terminal so that the second application part is extracted from the application message according to the identifier in the analyzed descriptor.

3. (Previously presented) A method according to Claim 1, wherein the loading means is installed in advance in the form of a software module in the terminal.

4. (Previously presented) A method according to Claim 1, further comprising the steps of introducing the loading means in the form of a script during the construction of the application message to be transmitted from the server to the terminal and installing the loading means by extraction of the script in the application message received by the terminal before loading the second application part.

5. (Previously presented) A method according to Claim 1, further comprising the steps of introducing an address of a loading script during the construction of the application message to be transmitted from the server to the terminal, installing the loading means by extraction of the script address in the application message received by the terminal, and downloading the script from the extracted address in the terminal before loading the second application part.

6. (Previously presented) A method according to Claim 1, further comprising, after the step of loading the second application part the step of deleting the second application part in the terminal.

7. (Previously presented) A method according to Claim 1, further comprising, after the step of loading the second application part, the step of transmitting an acknowledgement message from the terminal to the server as soon as the management means has finished loading the second application in the chip card.

8. (Previously presented) A method according to Claim 1, wherein the second application part is segmented into protocol units which are in accordance with the communication protocol and which are loaded successively in the chip card under the control of the loading means, and further including the step of transmitting from the chip card an acknowledgement response after the loading of each protocol unit.

9. (Previously presented) A method according to Claim 1, wherein the first and second application parts are written in high-level languages and are converted into an intermediate language that can be interpreted respectively by virtual execution means respectively implemented in the terminal and the chip card.

10. (Previously presented) A method according to Claim 1, wherein the terminal is a mobile radiotelephone terminal.

11. (Previously Presented) A method for loading a message including application components from a server to a terminal, said message including a first part identified for installation on the terminal and a second part identified for installation on a chip card accepted in the terminal, the method comprising the following steps:

- receiving, over a single transmission channel between the server and terminal, the application message containing the first application part and the second formatted application part;

- installing in the terminal the first application part extracted from the application message via a management means; and

- loading the second application part extracted from the application message from the terminal into the chip card under the control of a loading means received from the server.

12. (Previously Presented) A computer-readable medium storing program instructions that, when executed by a processor, instruct the processor to perform a method for loading a message including application components into a terminal, said message including a first part identified for installation on the terminal and a second part identified for installation on a chip card accepted in the terminal, the method comprising the following steps:

- receiving, over a single transmission channel between the terminal and a server, the message containing the first application part and the second formatted application part;

- installing the first application part extracted from the application message in the terminal; and

- loading the second application part extracted from the application message from the terminal into the chip card under the control of a loading means received from the server.

13. (Previously Presented) A system for loading a message including application components, the system comprising:

- a server;

- a terminal including a loading means received from the server;

a chip card detachably connected to the terminal; and
a transmission channel between the server and terminal,
wherein the terminal is configured to:

- receive over the transmission channel an application message including a first application part identified for installation on the terminal and a second formatted application part identified for installation on the chip card;
- install the first application part; and
- load the second application part extracted from the application message from the terminal into the chip card under the control of the loading means.

IX. EVIDENCE APPENDIX

None

X. RELATED PROCEEDINGS APPENDIX

None